



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,587	03/31/2004	David Stein	2006P26235 US	4314
28524	7590	07/11/2008	EXAMINER	
SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 170 WOOD AVENUE SOUTH ISELIN, NJ 08830			TURK, NEIL N	
		ART UNIT	PAPER NUMBER	
				1797
		MAIL DATE	DELIVERY MODE	
		07/11/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/813,587	STEIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	NEIL TURK	1797

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED July 2<sup>nd</sup>, 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  They raise the issue of new matter (see NOTE below);
- (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13.  Other: \_\_\_\_\_.

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797

Continuation of 11. does NOT place the application in condition for allowance because: of arguments of record. Applicant argues that with the objection to the Specification is improper and further argues with respect to claims 1-20 rejected under 35 USC 112, 2nd paragraph, that such means for language meets the definiteness requirement. Examiner asserts that the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1). (Emphasis added). Further, Examiner asserts that there should be clear support or antecedent basis in the specification and drawings for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP 1302.05 and also 37 CFR 1.121(e) which requires substantial correspondence between the language of the claims and the language of the specification. Examiner notes that as the original claims of the Application contain the "means for" language, Applicant may amend the specification in such a manner to include the "means for" phrase, and in a way that delineates the list of materials or structures that provide for the various "means for" recitations in the claims. Examiner also notes that as Applicant argues that "means for loading..." would be understood by one of ordinary skill in the art, and by this Applicant points to disclosure of, "samples are loaded into the immunoanlayzer either from the sample rack or by an operator." Examiner notes that the recitation of "...from the sample rack" does not point to a possible structure or material for performing the "means for loading", but instead points to a destination. Further, Applicant points to figure 10 in which a disclosure to a pipetting station 203 is exemplified. These arguments are not clear as the first supposed set of "means for loading" are drawn to a previous destination, i.e. from the sample rack, or by an operator, and the second disclosure is drawn to a pipetting station. It is thereby unclear what provides for the "means for loading..." Further, within Applicant's "Second" argument related to the "means for identifying tests to be performed...", the related disclosure does not have a direct correspondence to the claimed "means for" recitation. The related disclosure is drawn to a bar code reader, RF tag, or other means for identifying the samples, and not means for identifying the tests to be performed. Examiner asserts that a bar could provide for encoding the tests to be performed, and such encoded information would be able to be read out by a bar code reader. Examiner asserts that the disclosure in the specification is still unclear with regards to the "means for identifying..." and clarification is required. Further, within the "Third" argument directed to the "means for moving...", Applicant's related disclosure does not draw a direct correspondence and requires clarification. Further, with regards to Applicant's "Fourth" and "Fifth" arguments related to "means for setting..." and "means for modifying..." Applicant's related disclosure does not have a direct correspondence and is still unclear. Further, both related disclosures that Applicant provides as basis for both "means for" recitations are, in parts, drawn to the same list of structural elements. It is thereby unclear which element(s) of the disclosure relates to the means for setting, and which relates to the means for modifying, or if a duplicate structural element has been claimed. Clarification is required. As discussed above, the specification must provide antecedent basis for the "means for language" and delineate which list of materials provide for such "means for" recitations. Outside of a set of materials or structural elements that correspond to the various "means for" recitations, Applicant has provided an open-ended list of materials that may provide for the various "means for" recitations in the claims. With regards to claims 2 and 14 rejected under 35 USC 112, 2nd paragraph, the rejection is maintained as the claims are unclear as previously stated with respect to the language of "optimized" and the phrase "a launch of test sequence", which is grammatically incorrect, thus adding to the lack of clarity in the claims. Claims 13-20 are maintained rejected under 35 USC 112, 2nd paragraph, as previously discussed in the Final Rejection. With regards to claims 1-20 rejected under 35 USC 102(b) in view of Hanawa (5,972,295), Examiner maintains the rejection as previously discussed and argued in the Final Rejection mailed 4/16/08.